

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant : Koichi SATO

Group Art Unit: 2622

Appl. No. : 09/824,248

Examiner: J. M. Villecco

Filed : April 3, 2001

Confirmation No. : 1314

For : CONTINUAL - IMAGE PROCESSING DEVICE

APPEAL BRIEF UNDER 37 C.F.R. §41.37

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Appeal Brief - Patents
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

This appeal is from the rejection of claims 9-10 and 12-16, as set forth in the Final Official Action of February 27, 2006, as maintained in the Advisory Action of May 17, 2006, and as maintained in the Notice of Panel Decision from Pre-Appeal Brief Review of July 11, 2006.

A Notice of Appeal and a Pre-Appeal Brief Request for Review were filed on May 30, 2006 (May 27, 2006 falling on a Saturday and May 29, 2006 falling on a Federal holiday) in response to the Final Official Action of February 27, 2006, and the extendible two-month period for filing an Appeal Brief was set to expire on July 31, 2006 (July 30, 2006 falling on a Sunday). However, from the mailing date of the Notice of Panel

Decision from Pre-Appeal Brief Review on July 11, 2006, a further one-month period for filing an Appeal Brief was set to expire on August 11, 2006. The requisite fee for filing an Appeal Brief under 37 C.F.R. §41.20(b) (2) is submitted herewith.

However, if for any reason the necessary fee is not associated with this file or the attached fee is inadequate, the Commissioner is authorized to charge the fee for the Appeal Brief and any necessary extension of time fees to Deposit Account No. 19-0089.

(1) **REAL PARTY IN INTEREST**

The real party in interest is PENTAX Corporation, as established by a change of name filed in the U.S. Patent and Trademark Office on August 1, 2006.

(2) **RELATED APPEALS AND INTERFERENCES**

No related appeals and/or interferences are pending.

(3) **STATUS OF THE CLAIMS**

Claims 1-8 and 11 (Cancelled)

Claims 9-10 and 12-16, all of the claims pending in this application, stand finally rejected and are the subject of this appeal. Appellant Appeals the decision of the Examiner to finally reject claims 9-10 and 12-16. A copy of claims 9-10 and 12-16 is attached as an Appendix to this brief.

(4) **STATUS OF THE AMENDMENTS**

No amendments to the claims were filed after the final rejection of the claims of February 27, 2006.

(5) SUMMARY OF THE CLAIMED SUBJECT MATTER

Initially, Appellant notes that the following descriptions are made with respect to the independent claims and include references to particular parts of the specification. As such, the following are merely exemplary and are not a surrender of other aspects of the present invention that are also enabled by the present specification as well as those that are directed to equivalent structures or methods.

Independent claim 9 recites an electronic still camera comprising: a memory that stores a discrete image obtained in a still photographing operation, and that stores, for each of a plurality of discrete images sequentially obtained in a continual still image photographing operation in which the plurality of discrete images are taken at an interval time set by an operator, a unique indicator that indicates whether said discrete image was sequentially recorded in the continual still image photographing operation; a determination processor that determines whether the plurality of discrete images were obtained in said continual still image photographing operation; and an image processor that continually reproduces said plurality of discrete images, as a common operation on said plurality of discrete images, at a same interval as that of said continual still image photographing operation, when it is determined, using said unique indicator, that said plurality of discrete images were obtained in said continual still image photographing operation.

In this regard, an exemplary embodiment of the present specification is shown in FIGs. 1-4 and disclosed at pages 3-16. The exemplary embodiment discloses an electronic still camera (90) comprising: a memory (40) that stores a discrete image obtained in a still photographing operation (page 9, lines 7-16), and that stores, for each

of a plurality of discrete images sequentially obtained in a continual still image photographing operation in which the plurality of discrete images are taken (page 9, line 3 to page 10, line 22) at an interval time set by an operator (page 10, lines 3-4), a unique indicator that indicates whether said discrete image was sequentially recorded in the continual still image photographing operation (page 9, lines 23-25, page 15, line 4 to page 16, line 16); a determination processor (31) that determines whether the plurality of discrete images were obtained in said continual still image photographing operation (page 12, line 12 to page 13, line 4); and an image processor (31) that continually reproduces said plurality of discrete images, as a common operation on said plurality of discrete images, at a same interval as that of said continual still image photographing operation, when it is determined, using said unique indicator, that said plurality of discrete images were obtained in said continual still image photographing operation (page 13, lines 5-25).

Independent claim 15 recites an electronic still camera, comprising: a recording processor that continually records a plurality of discrete images at a predetermined interval set by an operator in a continual still image photographing operation in which the plurality of discrete images are taken; and a memory that stores, for each of said plurality of discrete images, a unique indicator that indicates whether said discrete image was sequentially recorded in the continual still image photographing operation, wherein the unique indicator enables the plurality of discrete images to be continually displayed as discrete images at a same interval as that of said continual still image photographing operation.

In this regard, an exemplary embodiment of the present specification is shown in FIGs. 1-4 and disclosed at pages 3-16. The exemplary embodiment discloses an electronic still camera (90), comprising: a recording processor (31) that continually records a plurality of discrete images at a predetermined interval set by an operator (page 10, lines 3-4) in a continual still image photographing operation in which the plurality of discrete images are taken (page 9, line 3 to page 10, line 22); and a memory (40) that stores, for each of said plurality of discrete images, a unique indicator that indicates whether said discrete image was sequentially recorded in the continual still image photographing operation (page 9, lines 23-25, page 15, line 4 to page 16, line 16), wherein the unique indicator enables the plurality of discrete images to be continually displayed as discrete images at a same interval as that of said continual still image photographing operation (page 13, lines 5-25).

(6) GROUND OF REJECTION TO BE REVIEWED ON APPEAL

(A) The Rejection of Claims 9-10 and 12-16 under 35 U.S.C. §103(a) over ANDERSON (U.S. Patent No. 6,169,575) in view of SHIOJI (U.S. Patent No. 6,466,264).

(7) ARGUMENT

(A) The Decision to Reject Claims 9-10 and 12-16 under 35 U.S.C. §103(a) over ANDERSON et al. (U.S. Patent No. 6,169,575) in view of SHIOJI (U.S. Patent No. 6,466,264) is Improper, and the Decision to Reject Claims 9-10 and 12-16 on this Ground Should be Reversed.

In the Final Official Action of February 27, 2006, claims 9-10 and 12-16 were rejected under 35 U.S.C. §103(a) over ANDERSON (U.S. Patent No. 6,169,575) in view of SHIOJI (U.S. Patent No. 6,466,264). The rejection of each of claims 9-10 and 12-16 under 35 U.S.C. §103(a) over ANDERSON et al. (U.S. Patent No. 6,169,575) in view of SHIOJI (U.S. Patent No. 6,466,264) is improper and should be reversed. In this regard, Appellant hereinbelow addresses the rejection of independent claim 9, dependent claims 10 and 12-14, independent claim 15 and dependent claim 16 under 35 U.S.C. §103(a) over ANDERSON et al. (U.S. Patent No. 6,169,575) in view of SHIOJI (U.S. Patent No. 6,466,264) in the numerical order of the claims.

(1) Claim 9

With respect to the rejection of claim 9, the Final Official Action acknowledges at page 3 that ANDERSON "does not disclose a determination processor that determines whether the plurality of discrete images were obtained in said continual still image photographing operation; and an image processor that continually reproduces said plurality of discrete images, as a common operation on said plurality of discrete images, at a same interval as that of said continual still image photographing operation when it is determined using said unique indicator that said plurality of discrete images were obtained in said continual still image photographing operation". However, the Final Official Action asserts at pages 3-4 that SHIOJI "discloses a recording medium comprising image signals of different frame rates, wherein a reproducer reproduces the image signals of different frame rates in compliance with the frame rate information... [and] a determination processor that determines whether the plurality of discrete images

were obtained in said continual still image photographing operation... because the CPU determines a still image reproduction mode or a motion image reproduction mode". The Final Official Action also asserts at page 4 that SHIOJI discloses "an image processor that continually reproduces said plurality of discrete images, as a common operation on said plurality of discrete images, at a same interval as that of said continual still image photographing operation when it is determined using said unique indicator that said plurality of discrete images were obtained in said continual still image photographing operation... because the frame rate information is a unique indicator for indicating that a plurality of discrete images are obtained in a continual still image photography". The Final Official Action cites col. 1, lines 1-5; col. 3, lines 28-65; and FIG. 10, S61 of SHIOJI as disclosing those features of claim 9 which the Final Official Action acknowledges are not disclosed by ANDERSON.

The above-noted assertions of the Final Official Action with respect to the teachings of SHIOJI are in error. In this regard, the features of claim 9 which the Final Official Action acknowledges are not disclosed by ANDERSON are also not disclosed or suggested by SHIOJI, such that even the combination of ANDERSON and SHIOJI would not result in the combination recited in claim 9.

Rather, differing frame rates in SHIOJI are discussed in the context of a "motion image signal" and not for "a continual still image photographing operation in which the plurality of discrete images are taken at an interval time set by an operator". Further, SHIOJI explicitly distinguishes between still image signals and motion image signals, but does not disclose "a continual still image photographing operation in which the plurality of discrete images are taken at an interval time set by an operator" or the

related features recited in the pending claims. Accordingly, the proposed combination would not result in the features recited in the pending claims. The Final Official Action acknowledges the above-noted distinction between "still image" signals and "motion image" signals in SHIOJI, but still misinterprets features which relate to the "motion image signals" in SHIOJI as somehow disclosing the features of the "continual still image photographing operation" recited in claim 9.

For example, SHIOJI discloses, at col. 5, lines 9-12, that for "motion-image frame rate", two modes are provided, i.e., 30 fps to form 1 second of motion image with 30 still image frames, and 15 fps to form 1 second of motion image with 15 still image frames" (emphasis added). Further, SHIOJI makes clear that the "motion image" signals are distinct from "still image" signals. For example, Fig. 5 shows a "STILL IMAGE RECORD PROCESSING" at S7 (detailed in Figs. 6-7) and a "MOTION IMAGE RECORD PROCESS" at S9 (detailed in Figs. 8-9). Further, Fig. 10 shows a "STILL IMAGE REPRODUCE PROCESSING" at S63 (detailed in Figs. 11-12) and a "MOTION IMAGE REPRODUCE PROCESSING" at S65 (detailed in Figs. 13-14). Accordingly, the first "motion image signal having the first frame rate" and the "second motion image signal having a different second frame rate from the first frame rate" as described at col. 3, lines 28-67 in SHIOJI, do not disclose and are not related to "a plurality of discrete images sequentially obtained in a continual still image photographing operation in which the plurality of discrete images are taken at an interval time set by an operator" (emphasis added) as recited in claim 9. Further, the first "motion image signal having the first frame rate" and the "second motion image signal having a different second frame rate from the first frame rate" as described at col. 3, lines 28-67 in SHIOJI, do not

disclose and are not related to "a determination processor that determines whether the plurality of discrete images were obtained in said continual still image photographing operation; and an image processor that continually reproduces said plurality of discrete images, as a common operation on said plurality of discrete images, at a same interval as that of said continual still image photographing operation, when it is determined, using said unique indicator, that said plurality of discrete images were obtained in said continual still image photographing operation" (emphasis added) as recited in claim 9.

There is no disclosure whatsoever in SHIOJI that an operator would select a frame rate for any operation related to obtaining still images, let alone for "a continual still image photographing operation in which the plurality of discrete images are taken at an interval time set by an operator" as recited in claim 9. Therefore, even if the assertion that "the frame rate information is a unique indicator" is taken as true, the assertion that this information indicates "that a plurality of discrete images are obtained in a continual still image photography" (emphasis added) is demonstrably false.

Accordingly, even assuming, *arguendo*, that the combination of the teachings of ANDERSON and SHIOJI is proper, such combination would not result in the combination of features recited in claim 9.

Further, the object of ANDERSON is to provide "easily identifiable image groups of related images, including user-created groups". However, none of the proposed modifications to ANDERSON would contribute to this objective. In this regard, there is no proper motivation in the prior art to perform each of the numerous modifications to ANDERSON that are acknowledged to be necessary to obtain the combination of elements recited in the pending claims. Accordingly, the only motivation to modify

ANDERSON in the manner necessary to obtain the pending claims is the improper motivation to obtain the pending claims in hindsight.

Additionally, claim 9 is directed to features relating to a "continual still image photographing operation in which the plurality of discrete images are taken at an interval time set by an operator". The rejection of claim 9 does not appear to reflect proper consideration of the above-noted features, as should be evident from the incorrect assertion in the Advisory Action dated May 17, 2006, that

"the concept of a motion signal comprising a timed sequence of frame images is directly analogous to a continual still image photographing operation comprising a plurality of discrete images taken at an interval" (emphasis added).

A motion image is not the same as or analogous to a still image, and the documents applied in the Final Official Action themselves recognize the distinction between the two. Thus, the rejection of claim 9 is not based on either the features recited in claim 9 or the teachings of the documents applied in the rejection; rather, the rejection of claim 9 relies on an interpretation which ignores both the meaning of the features recited in claim 9 as well as the teachings of the documents applied in the rejection.

As explained above, any proper combination of the teachings of ANDERSON in view of SHIOJI does not result in the features recited in claim 9. Accordingly, ANDERSON in view of SHIOJI does not disclose or suggest the combination of features recited in claim 9. Therefore, at least for each and all of the numerous reasons set forth above, the decision of the Examiner to reject claim 9 over ANDERSON in view of SHIOJI should be reversed.

(2) Claims 10 and 12-14

Claims 10 and 12-14 are also allowable, at least for the reason that these claims depend from an allowable claim 9, respectively, and because these claims recite additional features that further define the invention recited in claim 9. Further, claims 10 and 12-14 are separately patentable over any proper combination of ANDERSON in view of SHIOJI (U.S. Patent No. 6,169,575) which fails to disclose, in the claimed combination, inter alia,

(i) *the electronic still camera of claim 9, wherein said image processor continually reproduces said plurality of discrete images as the common operation (claim 10);*

(ii) *the electronic still camera of claim 9, wherein said image processor continually deletes said plurality of discrete images as the common operation (claim 12);*

(iii) *the electronic still camera of claim 9, wherein said determination processor determines whether said plurality of discrete images were obtained in said continual still image photographing operation by reading image recording information recorded for each of said plurality of discrete images (claim 13); and*

(iv) *the electronic still camera of claim 13, wherein said image recording information comprises a continual-image flag recorded in a header area corresponding to an image recording area in which a discrete image is recorded (claim 14).*

Claim 13

For example, the features of claim 13 are not disclosed or suggested in SHIOJI, contrary to the assertions in the Final Official Action. In this regard, claim 13 recites "wherein said determination processor determines whether said plurality of discrete images were obtained in said continual still image photographing operation by reading image recording information recorded for each of said plurality of discrete images". Despite the clear recitation of claim 13, the Final Official Action asserts that such features are disclosed by teachings in SHIOJI of "recording a time sequential group of JPEG images on a motion image file, wherein a header is written comprising frame rate information; and detecting the frame rate of a motion image file" (emphasis added). As is evident from a comparison of the recitations of claim 13 and the assertions in the Final Official Action in rejecting claim 13, the Final Official Action does not reflect proper consideration of the features recited in claim 13.

Therefore, at least for each and all of the reasons set forth above, the rejection of claims 10 and 12-14 over ANDERSON in view of SHIOJI should be reversed.

(3) Claim 15

Similar to the above-noted features recited in claim 9, claim 15 recites a "memory that stores, for each of said plurality of discrete images, a unique indicator that indicates whether said discrete image was sequentially recorded in the continual still image photographing operation, wherein the unique indicator enables the plurality of discrete images to be continually displayed as discrete images at a same interval as that of said continual still image photographing operation".

The above-noted features of claim 15 are not disclosed, suggested or rendered obvious by ANDERSON in view of SHIOJI, at least for reasons similar to the above-noted reasons for the allowability of claim 9 over ANDERSON in view of SHIOJI. In this regard, various features of the combination recited in claim 15 are acknowledged to be absent from the teachings of ANDERSON. Further, as explained above with respect to the similar features recited in claim 9, SHIOJI does not disclose storing a "unique indicator that indicates whether [a] discrete image was sequentially recorded in the continual still image photographing operation" or that such a unique indicator would enable "the plurality of discrete images to be continually displayed as discrete images at a same interval as that of [a] continual still image photographing operation". In this regard, SHIOJI specifically acknowledges a difference between motion image signals and still image signals, and does not disclose or suggest the above-noted features which relate to the "continual still image photographing operation".

Accordingly, even the modification of ANDERSON with the teachings of SHIOJI would not result in the above-noted recitations in the combination of claim 15, at least insofar as the above-noted features are acknowledged to be absent from ANDERSON, and at least insofar as SHIOJI itself does not itself provide such features. Therefore, at least for each and all of the reasons set forth above, the rejection of claim 15 over ANDERSON in view of SHIOJI should be reversed.

(4) Claim 16

Claim 16 is also allowable, at least for the reason that this claim depends from an allowable claim 15, respectively, and because this claim recites additional features that

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further define the invention recited in claim 15. Further, claim 16 is separately patentable over ANDERSON in view of SHIOJI which fail to disclose, in the claimed combination, inter alia,

(i) *the electronic still camera of claim 15, further comprising: an image processor that continually performs a common operation on said plurality of discrete images (claim 16).*

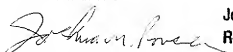
Therefore, at least for each and all of the reasons set forth above, the rejection of claim 16 over ANDERSON in view of SHIOJI should be reversed.

(8) **CONCLUSION**

Each and every pending claim of the present application meets the requirements for patentability under 35 U.S.C. §103(a), and the present application and each pending claim thereof is allowable over the prior art of record. Accordingly, Appellant respectfully requests that the Board of Patent Appeals and Interferences reverse the decision of the Examiner to reject claims 9-10 and 12-16 under 35 U.S.C. §103(a).

If there are any questions about this application, any representative of the U.S. Patent and Trademark Office is invited to contact the undersigned at the telephone number listed below.

Respectfully Submitted,
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CLAIMS APPENDIX

9. An electronic still camera comprising:

a memory that stores a discrete image obtained in a still photographing operation, and that stores, for each of a plurality of discrete images sequentially obtained in a continual still image photographing operation in which the plurality of discrete images are taken at an interval time set by an operator, a unique indicator that indicates whether said discrete image was sequentially recorded in the continual still image photographing operation;

a determination processor that determines whether the plurality of discrete images were obtained in said continual still image photographing operation; and

an image processor that continually reproduces said plurality of discrete images, as a common operation on said plurality of discrete images, at a same interval as that of said continual still image photographing operation, when it is determined, using said unique indicator, that said plurality of discrete images were obtained in said continual still image photographing operation.

10. The electronic still camera of claim 9, wherein said image processor continually reproduces said plurality of discrete images as the common operation.

12. The electronic still camera of claim 9, wherein said image processor continually deletes said plurality of discrete images as the common operation.

13. The electronic still camera of claim 9, wherein said determination processor determines whether said plurality of discrete images were obtained in said continual still image photographing operation by reading image recording information recorded for each of said plurality of discrete images.

14. The electronic still camera of claim 13, wherein said image recording information comprises a continual-image flag recorded in a header area corresponding to an image recording area in which a discrete image is recorded.

15. An electronic still camera, comprising:

a recording processor that continually records a plurality of discrete images at a predetermined interval set by an operator in a continual still image photographing operation in which the plurality of discrete images are taken; and

a memory that stores, for each of said plurality of discrete images, a unique indicator that indicates whether said discrete image was sequentially recorded in the continual still image photographing operation,

wherein the unique indicator enables the plurality of discrete images to be continually displayed as discrete images at a same interval as that of said continual still image photographing operation.

16. The electronic still camera of claim 15, further comprising:

an image processor that continually performs a common operation on said plurality of discrete images.

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EVIDENCE APPENDIX

None

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RELATED PROCEEDING APPENDIX

None